

## REMARKS

Claims 1-12 are pending and under consideration. Reconsideration is requested based on the following remarks.

### Response to Arguments:

The Applicants appreciate the consideration given to their arguments. The Applicants, however, are disappointed that their arguments were not found to be persuasive.

The Office Action asserts in section 5, in the last line at page 6, continuing at page 7, lines 1, 2, and 3, that:

Nitaki suggested that if the request is valid, the gateway download the contents data from the content server. Thus, clearly indicated that the contents data are directly from the content provider server.

To the contrary, in Nitaki, a user ID and a password (PW) must be entered *before* a menu for accessing the requested contents service even *appears*, rather than "providing the requested content service directly from the content provider to the user's portable telephone," as recited in, for example, claim 1. In particular, as described in Nitaki at paragraph [0110]:

At step S31, the address is transmitted to the gateway 22 as a request for use. Subsequently, a standby state is entered to wait for the reception of a user ID and PW associated with the request which are assigned by the gateway 22 (step S32: N). When the user ID and PW are received (step S32: Y), menu data for accessing the requested contents service which are simultaneously received are stored in the storage device and are registered as access request screen data (step S33).

Thus, in Nitaki, a user ID and PW associated with the request must be received before the menu from which the contents to be downloaded may be selected appears. This is to be contrasted with the claimed invention, in which "the menu registration identifier allows providing the requested content service directly from the content provider to the user's portable telephone."

Furthermore, in Nitaki, the user ID and password (PW) must be input at the menu screen before accessing the contents service. In particular, as described in Nitaki at paragraph [0111]:

When the access request screen is selected at step S30 (step S30: Y) or after a request for use is transmitted at step S31 to register a new menu screen, the input of the ID and PW is accepted according to the menu screen for accessing the relevant contents service (step S34). Thereafter, a request for use consisting of the ID and PW accepted at step S34 is transmitted to the gateway 22 at step S35. At step S36, reception of contents data associated with the request for use is monitored (step S36).

Thus, in Nitaki, the user ID and password (PW) must be input at the menu screen before accessing the contents service. This is to be contrasted with the claimed invention, in which "the menu registration identifier allows providing the requested content service directly from the content provider to the user's portable telephone."

Finally, in Nitaki, the gateway 22 only downloads contents data from the contents server 21 to the portable terminal 20 *after* a valid access request, i.e. the user ID and password (PW), is received from the portable terminal 20, rather than "providing the requested content service directly from the content provider to the user's portable telephone," as recited in, for example, claim 1. In particular, as described in Nitaki at paragraph [0113]:

When an access request is received from the portable terminal 20 and the access request is valid, the gateway 22 downloads contents data from the contents server 21 and transfers the contents data to the portable terminal 20. The gateway 22 will now be described.

Thus, in Nitaki, the gateway 22 only downloads contents data from the contents server 21 to the portable terminal 20 after a valid access request, i.e. the user ID and password (PW), is received from the portable terminal 20. This is to be contrasted with the claimed invention, in which "the menu registration identifier allows providing the requested content service directly from the content provider to the user's portable telephone." Further reconsideration is thus requested.

#### **Claim Rejections - 35 U.S.C. § 103:**

Claims 1-2 and 12 are rejected under 35 U.S.C. §103(a) as being unpatentable over JP 2000-333258 to Hiromoto (hereinafter "Hiromoto") in view of U.S. Patent Pub. No. 2001/0005890 to Nitaki (hereinafter "Nitaki") and further in view of U.S. Patent No. 6,957,199 to Fisher (hereinafter "Fisher"). The rejection is traversed. Reconsideration is requested.

Normally, a content provider sends content to the user's portable telephone, but the bill for the content, including charges for the content sent by the content provider, is sent to the user from the communications carrier, i.e. a proxy payment service. Thus, the communication carrier needs to know which content was accessed by the user, in order to bill the user. In order to keep track of which content was accessed by the user, the communication carrier requires the user to register with its own user menu information database as well. In particular, as described in the present specification at page 5, lines 2-14:

In this manner, the user can enjoy one-window payment through the proxy payment service, which is more convenient than the case where a credit card is used, with an added advantage that uneasiness and various problems are avoidable. However, since the billable content services for which the user can use

the proxy payment service are limited to the content services registered in the communications carrier's content provider menu information database 25, a payment from a user to a content provider has to be directly made for billable content services that are not registered.

However, in the conventional method, if the user sets up a "my," or personal, menu, and accesses the content of the content provider through the "my" menu, the content provider will be unable to recognize whether or not the access of the user comes through the "my" menu. To avoid missing the access, content providers require the user to register in order to access the content as well, as described in the specification at page 5, lines 24-33.

In the claimed invention, in contrast, the menu registration identifier allows the content provider to provide content to the user's portable phone without a separate registration process for the content. The menu registration identifier thus renders such a separate authentication process unnecessary. Therefore, it is possible to improve operability and ease of access to the content of the content provider, by dispensing with separate registration steps.

The fourth clause of claim 1, in particular, recites,

The menu registration identifier allows providing the requested content service directly from the content provider to the user's portable telephone.

Neither Hiromoto, Nitaki nor Fisher teach, disclose, or suggest, "the menu registration identifier allows providing the requested content service directly from the content provider to the user's portable telephone," as recited in claim 1. In Hiromoto, rather, the information menu center holds the contract information about information offered to a user, as noted astutely in section 2 at page 2 of the Office Action. Since, in Hiromoto, the information menu center holds the contract information about information offered to a user, the content provider is registering the user separately, as discussed above, and so Hiromoto is not "providing the requested content service directly from the content provider to the user's portable telephone," as recited in claim 1.

Similarly, in Nitaki, gateway 22 assigns a user ID and a password to the user the first time it receives an access request from the portable terminal 20, and transmits them to the portable terminal 20. In particular, as described in the Abstract:

When the gateway 22 receives the first request for access from the portable terminal 20, it assigns a user ID and a password to the same and transmits them to the portable terminal 20. When another request for use added with the same ID and PW is received, the gateway 22 generates access history information after authenticating the user and grants an access right during a predetermined effective period from the date of the first access.

Since, in Nitaki, gateway 22 assigns a user ID and a password to the user, the content provider

is registering the user separately, as discussed above, and so Nataki is not "providing the requested content service directly from the content provider to the user's portable telephone," as recited in claim 1.

The Office Action acknowledges graciously in section 2, at the top of page 3, that:

Hiromoto does not clearly teach a regular menu including contents, which will be available after our registration and the menu registration identifier allows providing requested content service directly from the content provider to the user's portable telephone.

The Office Action attempts to compensate for this deficiency of Hiromoto by combining Hiromoto with Nitaki. Modifying Hiromoto as proposed in the Office Action, however, would change the principle of operation of Hiromoto in violation of M.P.E.P. § 2143.01. In particular, as provided therein:

If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

Here, Hiromoto performs an authentication information read-out demand to accumulate the subscriber information. In particular, as described at paragraph [0005]:

An authentication information read-out demand is performed to the location register which is accumulating the subscriber information on a migration machine from the subscriber's number of the migration machine contained in said location registration demand signal.

Modifying Hiromoto as proposed in the Office Action, on the other hand, so that "the menu registration identifier allows providing the requested content service directly from the content provider to the user's portable telephone," as recited in claim 1, would change the principle of operation of Hiromoto, since Hiromoto would no longer perform an authentication information read-out demand to accumulate the subscriber information.

Hiromoto, furthermore, recognizes that the migration machine is a candidate for data utility by looking to see if the data utility status signal shows that the exchange which acquired the authentication information is the subscriber of the communications service included in the authentication information. In particular, as described at paragraph [0005]:

Recognize that said migration machine is a candidate for data utility with the data utility status signal which shows that the exchange which acquired said authentication information is the subscriber of the communications service included in said authentication information, and processing for authentication is performed between migration machines.

Modifying Hiromoto as proposed in the Office Action, on the other hand, so that "the menu registration identifier allows providing the requested content service directly from the content provider to the user's portable telephone," as recited in claim 1, would change the principle of operation of Hiromoto, since Hiromoto would no longer recognize that the migration machine is a candidate for data utility if the data utility status signal shows that the exchange which acquired the authentication information is the subscriber of the communications service included in said authentication information.

Fisher mentions no "menu registration identifier allows providing the requested content service directly from the content provider to the user's portable telephone," at all, and thus cannot make up for the deficiencies of either Hiromoto or Nitaki with respect to claim 1.

In the claimed invention, as shown in Fig. 4, the portable telephone 11 sends a request to the content provider 19 directly. The content provider 19, in turn, sends contents back to the portable telephone 11 directly, as discussed above and described from page 15, line 12 to page 16, line 20 of the specification. In the claimed invention, therefore, a separate authentication process is rendered unnecessary. The fourth clause of claim 1, in particular, recites:

And renders a separate authentication process unnecessary.

Neither Hiromoto nor Nitaki teach, disclose, or suggest "and renders a separate authentication process unnecessary," as recited in claim 1. The Office Action attempts to compensate for this deficiency of Hiromoto and Nitaki by combining them with Fisher, saying in section 2, in the third full paragraph at page 3, that:

However, Fischer teaches an authentication process for transactions that do not utilize separate authentication for registered users to eliminate an overhead authentication process (abstract; column 40 lines 43-52).

This is submitted to be incorrect. Fischer, to the contrary, cannot realize the above described process flow, let alone render "a separate authentication process unnecessary," as recited in claim 1. In the business method of Fisher, rather, as shown in Figs. 7 and 8, business 1 and business 2 always trade with each other through the PAMS system 100. Business 1 and business 2 are thus guaranteed to authenticate each other by passing through the PAMS system 100.

In Fisher, moreover, a group of authenticated users are connected under the *persistent* mediation of the on-line authentication service. In Fisher, therefore, the authentication state of each user is being audited *persistently* to make sure the user is authenticated. Thus, far from

rendering a separate authentication unnecessary, Fisher actually authenticates persistently. In particular, as described in the Abstract:

A service according to the invention is a persistent authentication and mediation service (PAMS) which is provided as an on-line service. One embodiment is a method for conducting authenticated business transactions involving microprocessor equipped devices over the Internet comprising: A. providing an on-line authentication service available on the distributed network; B. authenticating a plurality of users to said on-line authentication service using a closed authentication system to produce a plurality of authenticated users; and C. connecting a group of at least two of said plurality of authenticated users under persistent mediation of said on-line authentication service, producing a connected group of authenticated users.

Since, in Fisher, the authentication state of each user is being audited persistently to make sure it is valid, Fisher does not render "a separate authentication process unnecessary," as recited in claim 1.

The persistent authentication and mediation service (PAMS) of Fisher, moreover, monitors all of the interactions between authenticated users and compiles an audit trail. In Fisher, therefore, the authentication state of each user is being audited *constantly*, to make sure it is valid. In particular, as described at column 4, lines 57-67, continuing at column 5, lines 1, 2, and 3:

The invention pertains to a persistent authentication and mediation service (PAMS) which is provided as an on-line service on a public distributed network such as the Internet. As used herein, a PAMS is an online service provided over the network which is capable of authenticating groups of two or more users to each other by authenticating each user to the PAMS and connecting the authenticated users to each other under persistent mediation of the PAMS. Authentication refers to the processes of a first entity proving its identity to one or more other entities over the network. Mediation refers to the fact that communications between authenticated users pass through the PAMS giving the PAMS the capability to monitor the interaction and compile an audit trail.

Since, in Fisher, the persistent authentication and mediation service constantly monitors all of the interactions between authenticated users and compiles an audit trail, Fisher does not render "a separate authentication process unnecessary," as recited in claim 1.

The interactions of Fisher, moreover, remain mediated during the entire interaction under the PAMS. In Fisher, therefore, the authentication state of each user is being audited *constantly*, to make sure it is valid. In particular, as described at column 5, lines 4-10:

Persistent refers to the fact that interaction remains mediated during the entire interaction under the PAMS, and messages persist until delivered. Persistent messaging is based on asynchronous communication. The audit trail is compiled

by monitoring mediated messages and saving pre-selected or user selectable messages for permanent storage and retrieval. The content of messages may be stored and retrieved.

Since, in Fisher, the interactions remain mediated during the entire interaction under the PAMS, Fisher does not render "a separate authentication process unnecessary," as recited in claim 1.

Finally, in Fisher, the business itself does not need the overhead of a separate authentication mechanism in *addition* to the persistent mediation and authentication provided by the PAMS, because of the PAMS's assurance that they are dealing with an authentic business. In particular, as described at column 40, lines 43-52:

Although a business may be unfamiliar to another business, they are willing to trade with unfamiliar partners because of the PAMS's assurance that they are dealing with an authentic business, with known characteristics. Once a business logs onto the PAMS, it becomes part of an integrated community. Businesses of Type A, B or C can assume that anyone accessing their sites/applications has already be authorized by the PAMS, therefore, the business itself does not need the overhead of a separate authentication mechanism.

Since, in Fisher, the PAMS assures participants that they are dealing with an authentic business by monitoring the interactions persistently and compiling an audit trail, Fisher does not render "a separate authentication process unnecessary," as recited in claim 1. Thus, even if Hiromoto, Nitaki, and Fisher were combined as proposed in the Office Action, the claimed invention would not result. Claim 1 is submitted to be allowable. Withdrawal of the rejection of claim 1 is earnestly solicited.

Claims 2 and 12 depend from claim 1 and add further distinguishing elements. Claims 2 and 12 are also submitted to be allowable. Withdrawal of the rejection of claims 2 and 12 is earnestly solicited.

Claims 5, 7, and 11:

Claims 5, 7, and 11 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Hiromoto in view of Nitaki.

The sixth clause of claim 5 recites,

The menu registration identifier allows providing the requested content service directly from the content provider to the user's portable telephone.

Neither Hiromoto nor Nitaki teach, disclose, or suggest, "the menu registration identifier allows providing the requested content service directly from the content provider to the user's portable telephone," as discussed above with respect to the rejection of claim 1. Thus, even if Hiromoto

and Nitaki were combined as proposed in the Office Action, the claimed invention would not result. Claim 5 is also submitted to be allowable, for at least those reasons discussed above with respect to the rejection of claim 1. Withdrawal of the rejection of claim 5 is earnestly solicited.

Claim 7:

The fourth clause of claim 7 recites,

The menu registration identifier allows providing the requested content service directly from the content provider to the user's portable telephone.

Neither Hiromoto nor Nitaki teach, disclose, or suggest, "the menu registration identifier allows providing the requested content service directly from the content provider to the user's portable telephone," as discussed above with respect to the rejection of claim 1. Thus, even if Hiromoto and Nitaki were combined as proposed in the Office Action, the claimed invention would not result. Claim 7 is also submitted to be allowable, for at least those reasons discussed above with respect to the rejection of claim 1. Withdrawal of the rejection of claim 7 is earnestly solicited.

Claim 11:

The fourth clause of claim 11 recites,

The menu registration identifier allows providing the requested content service directly from the content provider to the user's portable telephone.

Neither Hiromoto nor Nitaki teach, disclose, or suggest, "the menu registration identifier allows providing the requested content service directly from the content provider to the user's portable telephone," as discussed above with respect to the rejection of claim 1. Thus, even if Hiromoto and Nitaki were combined as proposed in the Office Action, the claimed invention would not result. Claim 11 is also submitted to be allowable, for at least those reasons discussed above with respect to the rejection of claim 1. Withdrawal of the rejection of claim 11 is earnestly solicited.

Claims 3, 4, 6, and 8-11:

Claims 3, 4, 6, and 8-11 were rejected under 35 U.S.C. § 103(a) as unpatentable over Nitaki in view of Hiromoto. The rejection is traversed. Reconsideration is requested.

The sixth clause of claim 3 recites,



The menu registration identifier allows providing the requested content service directly from the content provider to the user's portable telephone.

Neither Hiromoto nor Nitaki teach, disclose, or suggest, "the menu registration identifier allows providing the requested content service directly from the content provider to the user's portable telephone," as discussed above with respect to the rejection of claim 1. Thus, even if Hiromoto and Nitaki were combined as proposed in the Office Action, the claimed invention would not result. Claim 3 is also submitted to be allowable, for at least those reasons discussed above with respect to the rejection of claim 1. Withdrawal of the rejection of claim 3 is earnestly solicited.

Claim 4 depends from claim 3 and adds further distinguishing elements. Claim 4 is thus also submitted to be allowable. Withdrawal of the rejection of claim 4 is earnestly solicited.

Claim 6:

The third clause of claim 6 recites,

The menu registration identifier allows providing the requested content service directly from the content provider to the user's portable telephone.

Neither Hiromoto nor Nitaki teach, disclose, or suggest, "the menu registration identifier allows providing the requested content service directly from the content provider to the user's portable telephone," as discussed above with respect to the rejection of claim 1. Thus, even if Hiromoto and Nitaki were combined as proposed in the Office Action, the claimed invention would not result. Claim 6 is also submitted to be allowable, for at least those reasons discussed above with respect to the rejection of claim 1. Withdrawal of the rejection of claim 6 is earnestly solicited.

Claim 8:

The fifth clause of claim 8 recites,

The menu registration identifier allows providing the requested content service directly from the content provider to the user's portable telephone.

Neither Hiromoto nor Nitaki teach, disclose, or suggest, "the menu registration identifier allows providing the requested content service directly from the content provider to the user's portable telephone," as discussed above with respect to the rejection of claim 1. Thus, even if Hiromoto and Nitaki were combined as proposed in the Office Action, the claimed invention would not result. Claim 8 is also submitted to be allowable, for at least those reasons discussed above with respect to the rejection of claim 1. Withdrawal of the rejection of claim 8 is earnestly

solicited.

Claims 9 and 10 depend from claim 8 and add further distinguishing elements. Claims 9 and 10 are thus also submitted to be allowable. Withdrawal of the rejection of claims 9 and 10 is earnestly solicited.

Claim 11:

Neither Hiromoto nor Nitaki teach, disclose, or suggest, "the menu registration identifier allows providing the requested content service directly from the content provider to the user's portable telephone," as discussed above with respect to the rejection of claim 11 as unpatentable over Hiromoto in view of Nitaki. Thus, even if Hiromoto and Nitaki were combined as proposed in the Office Action, the claimed invention would not result. Claim 11 is also submitted to be allowable. Withdrawal of the rejection of claim 11 is earnestly solicited.

**Conclusion:**

Accordingly, in view of the reasons given above, it is submitted that all of claims 1-12 are allowable over the cited references.

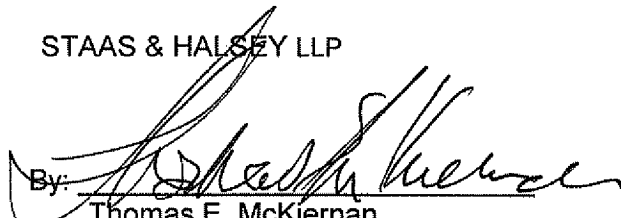
If there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

STAAS & HALSEY LLP

Date: 10 AUG 07

By:   
Thomas E. McKiernan  
Registration No. 37,889

1201 New York Avenue, NW, 7th Floor  
Washington, D.C. 20005  
Telephone: (202) 434-1500  
Facsimile: (202) 434-1501